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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,491	04/25/2005	Joachim Guettinger	R.305861	4359

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EXAMINER

NGUYEN, TRAN N

ART UNIT	PAPER NUMBER
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2834

MAIL DATE	DELIVERY MODE
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09/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/532,491	GUETTINGER ET AL.	
	Examiner	Art Unit	
	Tran N. Nguyen	2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 13, 15, 16, 23, 27, 29, 30, 32 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 13, 15, 23, 27, 29, 32, 34 and 36-39 is/are rejected.
- 7) ☒ Claim(s) 16 & 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 8/1/07 have been fully considered but they are not persuasive.

The applicant argues *that the housing cap 10 of Kluck is integrally formed as a single flexible element, and the housing cap of Watson is integrally formed as a single flexible element. The claims clearly define that the elastic region (4) is disposed inside the housing cap and is not identical with the housing cap. The invention to which the current claims are drawn (Figs. 1 and 2) embodies the elastic region as a separate element, of an elastomer element disposed in and secured in the housing cap Kluck provides no instructions whatsoever on providing for an independently formed elastomer element. In Watson, which has a snap acting mechanism for a bistable electric switch as its content, a flexible housing part is disclosed, but in Watson it is embodied completely as a housing cap (3). However, the content of Watson with the electric switch is far away from the teachings according to Kluck of calibrating a commutator of an electric motor through the housing wall.*

The applicant's attention is drawn to Kluck's figs 1-4, particularly figs 1-2, shows that the elastic region, defined by portion 24 and pin 23, that enables positioning the brush holder 13, 14 relative to the commutator from the outside. **Kluck's fig 2 shows that the elastic region's portion 24 is located in the housing cap (10)** and Kluck particularly discloses that the **elastic region's portion 24 is a circular portion**, i.e., shaped as a cylinder (col 3 lines 10+). Thus, it would have been obvious to an artisan to apply the Watson's teaching of the concept of independently formed elastic region, to modify the Kluck's end cap so that the elastic region is

an independent formed elastic element, and **since Kluck's the elastic region in is originally located in the housing cap at the appropriate location for enabling the positioning of the brush holder, the modified independently-formed elastic element would still be disposed in the housing cap.**

Regarding the applicant's argument that *Watson with the electric switch is far away from the teachings according to Kluck of calibrating a commutator of an electric motor through the housing wall.*

In response to applicant's argument, which seems to imply that Watson is nonanalogous art with respect to Kluck, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), and recently *KSR international Co. V. Teleflex Inc* 82 USPQ2d 1385 (2007). In this case, Watson's teaching is reasonably pertinent to solve the problem of enhancing the elastic element's capacity to enable positioning the brush holder.

However, in light of the applicant's remarks, the rejections against claims 16 and 35 are withdrawn, and these claims are allowable.

Claim Rejections - 35 USC § 112

Claims 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 37, the term “*certain extent*” in the phrase “*the commutator is variable to a certain extent*” is indefinite because it is a relative term that is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 38, “*the electrical machine according to claim 11 further comprising a slight press fit between the brush holder and the housing*” is indefinite because “press fit” is a force, not an physically structural element; furthermore, the term “slight press fit” is indefinite because it is a relative term that is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The above phrase is understood as “, “*the electrical machine according to claim 11, wherein the brush holder is pressed fit in the housing.*”

In claim 39, the recitation of claim 39 is a process claimed language, wherein the die element (10) is not a functionally operational part of the machine, but it is a device/apparatus for adjusting the elastomer element (4) so that the elastomer enable to position the brush holder. This is a method of assembling claim.

A "product by process" claim is directed to the product per se, no matter how actually made, *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmimn*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of

which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Thus, the method of forming a device is not germane to the issue of patentability of the device itself.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 13, 15, 23, 32, 34, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kluck (US 4596941)** in view of **Watson (US 3094594)**.

With respect to claims 11 and 13, Kluck teaches an electrical machine comprising: A housing for a machine, the housing including a housing body (Col. 2, Lines 36-38) and a housing cap (Fig. 1, #10), a brush holder (Fig. 1, #13 & 14) disposed in the housing for holding brushes (Fig. 1, #11 & 12), and an elastic region (Fig. 1, #24) in the housing cap which enables positioning of the brush holder relative to the commutator from outside the housing (Col. 3, Lines 54-61), wherein the elastic region is disposed and secured in the housing cap, and wherein a seal is achieved between the elastic region and the housing cap, but it does not explicitly teach the elastic region being an independently formed elastomer element.

However, **Kluck** teaches that the housing cap is made of a plastic (Col. 1, Lines 54-58) that can flex, and **Watson** teaches independently formed elastic regions (Fig. 1, #23) for use in an electric device. It would have been obvious to one of ordinary skill in the art at the time of the invention to: (1) form the elastic region of Kluck from an elastomeric plastic since an elastomeric plastic would fulfill the requirements of Kluck, and (2) form the elastic region of Kluck independently such as is taught by Watson because it provides an equivalent and equally well-known means for providing an elastic element for an electrical component housing that is simple in design and easy to manufacture (Col. 1, Lines 10-33).

It also would have been obvious to: (1) form the elastic region from an elastomer since it has been held that one of ordinary skill in the art at the time the invention would choose a suitable and desirable material, because it would be within the general skill of a worker in the art to select a material on the basis of its suitability for the intended use as a matter of obvious design choice (In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960)), and (2) independently form the elastic region of Kluck in the manner as taught by Watson since it has been held that making a one piece component into two separate pieces is not considered to be patentably distinct (In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348,349 (CCPA 1961)).

With respect to claim 15, Kluck in view of Watson teaches the machine of claim 11, wherein the elastomer element is an elastomer diaphragm.

With respect to claim 23, Kluck in view of Watson teaches the machine of claim 11, and Watson teaches that the electrical machine is watertight (Col. 1, Lines 37-42).

With respect to claims 32 and 38, Kluck in view of Watson teaches the machine of claim 11, wherein the brush holder is disposed in the housing. The limitation of the brush holder being disposed by way of a slight press fit is a method limitation given little patentable weight in an apparatus claim (see court ruling regarding "product by process" claim, as quoted in the above section).

With respect to claim 34, Kluck in view of Watson teaches the machine of claim 11, wherein there is a seal between the housing body and the housing cap (Kluck, Col. 1, Lines 37-42, since the entire machine is water tight, there is a seal inherently formed between the housing body and the housing cap).

With respect to claim 37, Kluck in view of Watson teaches the machine of claim 11, wherein Kluck discloses a brush holder (Fig. 1, #13 & 14) as lever that is relatively resilient; thus, obviously the resilient brush holder lever's positioning would be varied with respect to the commutator.

Claims 27 & 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hayashi (US 2002/0175573)** in view of **Kluck (US 4596941)** and **Watson (US 3094594)**.

Hayashi teaches a windshield wiper motor (Fig. 15, #1) for use in a vehicle, but it does not teach the brush holder and elastic region of claim 11.

However, **Kluck in view of Watson** teaches the brush holder and elastic region of claim 11. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the brush holder of Hayashi in view of the brush holder and elastic region as taught by Kluck and Watson because it provides a means for simply assembling an electric machine without requiring any tools (Kluck, Col. 1, Lines 37-42).

Allowable Subject Matter

Claims 16 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran N. Nguyen whose telephone number is 571-272-2030. The examiner can normally be reached on 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 571-272-2044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. (Note: Use this **Central Fax number 571-273-8300 for all official response.**)

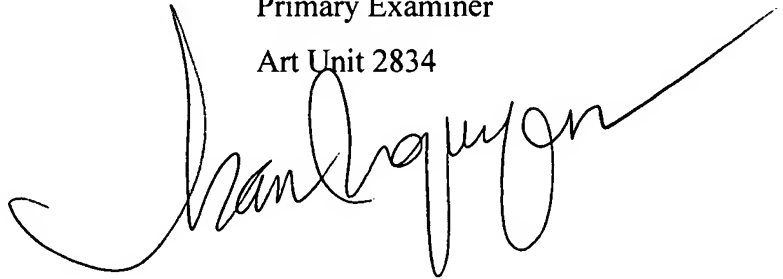
Do **not** use the Examiner's RightFax number without informing the Examiner first because, according to the USPTO policy, any document being sent via RightFax is treated as unofficial response and will not be officially dated until it is routed to the Central Fax.

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Tran N. Nguyen

Primary Examiner

Art Unit 2834

A handwritten signature in black ink, appearing to read 'Tran N. Nguyen', with a long, sweeping horizontal stroke extending to the right.